

REMARKS

Claims 14-29 are all the claims pending in the application.

Claims 14-25 are rejected under 35 U.S.C. § 112, first paragraph.

Claims 14-17, 19, 21-24 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang, "Data Resource Selection in Distributed Visual Information Systems", I.E.E.E. Knowledge and Data Engineering, Volume 10, pages: 926-946, November 1998.

Claims 18, 20 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

The Applicants traverse the rejections and request reconsideration.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Rejection of Claims 14-25 based on § 112, First Paragraph

In the previous amendment, the claims were amended to recite that the computation of the textual dissimilarity requires no input from the user. The Examiner incorrectly finds the limitation related to the computation to be not supported in the Specification.

"[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, (CCPA 1977). In essence, the "written description" requirement requires that each and every element in the claims be adequately described in the Specification to show one of skill in the art that the inventor was in possession of the invention at the time the application was filed. *See* Manual Of Patent Examining Procedure ("MPEP") § 2163.02. Further, "all that is necessary to satisfy the description requirement is to show that one is 'in

possession' of the invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). "One shows that one is 'in possession' of the invention by describing the invention, with all of its claim limitations." *Id.*

However, it is well settled that "[i]t is not necessary that the claimed subject matter be **described identically**, but the disclosure originally filed must convey to those skilled in the art that the applicant has invented the subject matter claimed." *In re Wilder*, 736 F.2d 1516, 1520 (Fed. Cir. 1984) (citation omitted). Indeed, "[i]n order to satisfy the written description requirement, the disclosure as originally filed **does not have to provide in haec verba support** for the claimed subject matter at issue." *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002); *See In re Werthheim*, 541 F.2d 257, 265 (CCPA 1976) ("Lack of literal support...is not enough...to support a rejection under § 112."). Moreover, the "failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented." *All Dental Prodx, LLC v. Advantage Dental Prods.*, 309 F.3d 774, 779 (Fed. Cir. 2002).

The Examiner cites MPEP 2173.05(i) regarding negative limitations and notes that any claim containing a negative limitation which does not have a basis in the original disclosure should be rejected as failing to comply with the written descriptions requirement. However, in the very next sentence it is noted that a lack of **a literal basis** in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support.

The Applicants respectfully submit that while the Specification may not provide literal support for the above-discussed limitation, a skilled artisan reading the Specification will know that in computing textual dissimilarity, no input is provided by the user. For example, each of the equations in steps 202-208 of Fig. 2 does not require any input by the user.

Further, referring to FIG. 1, the dissimilarity $D(i,j)$ of two input images is automatically calculated without any input from the user. A skilled artisan reading the Specification will know that in computing textual dissimilarity, no input is provided by the user.

Claim Rejections Under 35 U.S.C. § 102

Rejection of Claims 14-17, 19, 21-24, and 26-29 based on Chang

The Examiner continues to maintain that Chang teaches automatic dissimilarity computation. However, previously argued by the Applicants, Chang requires user input. The computation in Chang is not completely automatic as in the present invention. It requires human intervention as noted in p. 938, 1st paragraph, 1st column. The Examiner cites p. 926 2nd column where it is merely asserted that searching the metadatabases involves determining visual similarity of the query with the abstracted visual information recorded about the databases. However, this is not an explicit teaching about automatically determining a statistical dissimilarity and automatically determining a perceptual dissimilarity and automatically determining a textual dissimilarity without input from the user.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

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Cir. 1987). The present invention, is not anticipated by Chang at least because of the above noted differences.


Allowable Claims

The Examiner is requested to hold the status of the allowable claims in abeyance pending resolution of the status of the base claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: October 23, 3006